

IN THE CLAIMS

1-94. (cancelled)

95. (New) A method of co-branding pages sent over a network, the network having a plurality of referring sites and a destination site, the method comprising:

receiving a request from a user for a page of the destination site, wherein the user was referred to the destination site by one of the plurality of referring sites,

after receiving the request, the destination site generating a page comprising a visual representation of the brand of the referring site, a visual representation of the brand of the destination site, and text or graphics relating to products or services offered via the destination site, wherein the brand of the referring location is one of a plurality of brands stored and accessible by the destination site,

transmitting the page to a user,

transmitting tracking information to the entity operating the referring site that referred the user to the destination site, wherein the tracking information includes information relating the user's transaction for products or services offered via the destination site.

96. (New) The method of claim 95 wherein the network includes client and server computers and wherein servers are disposed at the sites and a client computer is used by user.

97. (New) The method of claim 95 wherein the network is the Internet.

98. (New) The method of claim 97 wherein the location of the destination site is provided by the referring site to the user via a hypertext link.

99. (New) The method of claim 95 wherein the sites are specified by network addresses.

100. (New) The method of claim 99 wherein the sites are defined by URL's.

101. (New) The method of claim 100 wherein the addresses of the first, second and third sites have different domain names.

102. (New) The method of claim 95 wherein the step of generating a page further includes customizing the products or services to be displayed based on the referring site.

103. (New) The method of claim 102 wherein the step of customizing the products of services to be displayed further comprises customizing the product and services in accordance with stored requirements provided by the referring site.

104. (New) A method of co-branding pages sent over a network, the network having a plurality of referring sites and a destination site, the method comprising:

storing a plurality of brands such that a least one brand is associated with each of the plurality of referring sites and the stored brands are accessible by the destination site,

receiving a request from a user for a page of the destination site, wherein the user was referred to the destination site by one of the plurality of referring sites,

after receiving the request, the destination site generating a page comprising a visual representation of the brand of the referring site, a visual representation of the brand of the destination site, and text or graphics relating to products or services offered via the destination site, and transmitting the page to a user.

105. (New) The method of claim 104 wherein the network includes client and server computers and wherein servers are disposed at the sites and a client computer is used by user.

106. (New) The method of claim 104 wherein the network is the Internet.

107. (New) The method of claim 106 wherein the location of the destination site is provided by the referring site to the user via a hypertext link.

108. (New) The method of claim 104 wherein the sites are specified by network addresses.

109. (New) The method of claim 108 wherein the sites are defined by URL's.

110. (New) The method of claim 109 wherein the addresses of the first, second and third sites have different domain names.

111. (New) The method of claim 104 wherein the step of generating a page further includes customizing the products or services to be displayed based on the referring site.

112. (New) The method of claim 104 wherein the step of customizing the products of services to be displayed further comprises customizing the product and services in accordance with stored requirements provided by the referring site.

113. (New) The method of claim 95 or 104 wherein the request from the user for a page is received at the destination site.

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Exhibit A: Parent Patent, U.S. Patent No. 6,141,666

Exhibit B: Declaration of William Tobin

Exhibit C: Last Office Action from U.S. Application No. 09/271,675

Exhibit D: Nee, S., Greetings For All Seasons: Part Two," Sales and Marketing Management,
Vol. 1416", No. 10, pp. 139-152 (September 1994)

I. PROCEDURAL HISTORY

Applicant submits the present amendments and remarks in response to the Office Action

having a mailing date of May 7, 2004, which rejected claims 60-84.

Before the Applicant received an Office Action, the Applicant filed a preliminary amendment on April 21, 2004, in which Applicant canceled claims 60-84, and added new claims 85-94.

On July 26, 2004, the undersigned counsel participated in an interview with the Examiner to discuss this matter, requesting how best to proceed. Upon review of the file, the Examiner advised that, even though the preliminary amendment predated the Office Action, the Examiner did not enter the preliminary amendment under 37 C.F.R. § 1.115, as Applicant filed it later than three months from the filing date of the application.

On August 20, 2004, the Applicant filed an appeal brief on claims in a different but related application, U.S. Patent Application No. 09/271,675 (which was before Examiner S.S. Hong).

The Examiners in both this application and the application on appeal have made somewhat related arguments based on different prior art. Moreover, although the Applicant had every expectation of success in the appeal of the related case, the Applicant believes that some of the claims that were on appeal would benefit from additional amendment.

Accordingly, Applicant is canceling the claims in this application (09/781,354), and replacing them with an amended version of the claims that were on appeal in the related application (09/271,675). Applicant has also dropped the appeal in the related application in favor of proceeding with the claims in this application.

The new claims are numbered 95-113 in order to prevent any confusion with the claims 85-94, which were filed by Applicant on April 21, 2004, but not entered by the Examiner.

II. SUMMARY OF INVENTION

To help the Examiner understand the claims, the Applicant will provide a walk-through of just one of the possible embodiments of independent claim 104. Applicant also cites to examples of the claim elements in the specification by referring to the issued parent patent attached as Exhibit A. However, such references are not exhaustive and are by way of example only. Moreover, the elements of the claim are not limited to the specific examples. Although Applicant refers to all of the claims as comprising a single "invention," Applicant uses such term for ease of reading only, and it should be understood that each claim covers different and distinct subject matter.

A. Referring Users To A Destination Site

The claimed invention provides a method of co-branding pages sent over a network having a plurality of referring sites and a destination site. (*See, e.g.*, Exh. A, network Figure 1A; col. 9.)

The Web sites fall into two categories. One category of Web sites comprises Web sites (hereafter "referring Web sites") that refer a user to another Web site. For example, a referring Web site may be an Internet portal that is well known and trusted by users, such as Pathfinder or AOL. The

Internet portal typically refers the users to other Web sites via the use of a clickable hyperlink. (*See, e.g.*, Fig. 11A; col. 9, lns. 6-14.)

The other category comprises the destination of these referrals, namely, the destination Web site. For example, the hyperlink may lead to a Web site that provides products or services, such as the flowers and gifts offered on the PC Flowers & Gifts Web site. (*See, e.g.*, Figs. 11C-20; col. 9, lns. 15-30.)

B. Generating A Page After The Referral Occurs So That It Includes Three Different Items Of Information

The fact that there are referring Web sites and destination Web sites is not unique. However, what is unique in light of the prior art is what the claimed invention does upon receiving the referral.

After the destination site receives the request from the user, the destination Web site generates a custom web page that includes three different items of information.

The first item is "a visual representation of the brand of the referring location."

The second item is "a visual representation of the brand of the destination site."

The third item is "text, graphics or sounds relating to products or services offered via the destination site."

Each of the items is discussed in more detail in the following sections.

C. Generating A Page So That The Page Includes The Brand Of The Referrer Where (i) The Brand Was Stored With A Plurality Of Other Referrer Brands, (ii) The Brand Is Visually Represented On The Page, And (iii) The Brand Represents The Site That Made The Referral

The claim requires that the referrer's brand meet particular requirements. One requirement is that it must be a "visual representation of the brand." (*See, e.g.*, "Pathfinder" designation 1116' in Fig. 11C; col. 9, lns. 15-17.) Accordingly, the fact that a web page may have some arbitrary values related to the referrer stored in the HTML code and invisible to the user is not a "visual representation of the brand."

Another requirement is that the brand has to be the brand of the site that just made the referral. The claim states that the brand must be "the brand of the referring location" where "the user was referred to the destination site by one of the plurality of referring sites." Accordingly, not just any brand of a referrer will do; the page must include at least the brand of the site that made the referral. (*See, e.g.*, col. 9, lns. 6-14.)

Another requirement of the "storing" step is that the destination site has access to a plurality of referrer's brands. For example, the PC Flowers & Gifts Web site would have access to the brands of Pathfinder, HomeArts, and other major Web sites and on-line services. (*See, e.g.*, col. 3,

lns. 23-36; col. 5, ln. 46 to col. 6.) (Claim 95 does not specifically require a storing step, but does recite that the brand of the referring location is one of a plurality of brands stored and accessible by the destination site.)

D. Generating A Page So That The Page Also Includes The Brand Of The Destination Such That The Brand Is Visually Represented On The Page

The second item to be included on the newly generated web page is "a visual representation of the brand of the destination site." For example, the PC Flowers & Gifts displays the "PC Flowers & Gifts" brand above the Pathfinder brand. (*See, e.g., "PC Flowers & Gifts" designation 1116 in Fig. 11C; col. 9, lns. 16-19.*)

E. Generating A Page So That The Page Includes Text, Or Graphics Relating To Products Or Services Offered Via The Destination Site

The third item to be included on the newly generated web page comprises "text or graphics relating to products or services offered via the destination site." For example, the PC Flowers & Gift Web site displays pictures and descriptions of flowers for sale. (*See, e.g., reference 1103 in Fig. 11C.*)

F. The Page Is Generated After The Referral

Another element of the independent claims is that the page is not "*generated*" to include all of the foregoing items until "*after*" the request for the page is received from the user. (*See, generally e.g., col. 3, lns. 23-42; customization based on tokens, col. 10, lns. 28-37; col. 11, lns. 11-14; customizing after access of HTML document via hyperlink, col. 10, lns. 37-48.*)

Specifically, the claim requires "receiving a request from a user for a page of the destination site." Then, "after receiving the request," the destination site will generate a page which includes the three items of information meeting all of the requirements set forth above.

The foregoing example can be used again to illustrate how it may work. *After* the user asked for a page from the PC Flowers & Gifts Web site by clicking on a link on the Pathfinder Web site (*see, e.g., 11B, reference 1183*), the PC Flowers & Gifts Web site would generate a page that included: (1) a visual representation of AOL's brand; (2) a visual representation of PC Flowers & Gifts' brand, and; (3) text, graphics, and/or sounds relating to the flowers and gifts sold by PC Flowers & Gifts (*see, e.g., Fig. 11C*).

Applicant acknowledges that the claim does *not* require that every individual item of information needs to be generated after the referral. What needs to be generated after the request is received is expressly stated in the claim: a page that includes all three items of information. In other words, the page is assembled to include all three items of information in response to the referral.

G. The Page Is Transmitted To The User

After the page is generated, it is transmitted to the user. (*See, e.g.*, col. 3, lns. 14-18; Fig. 31.)

H. Tracking And Other Dependant Claims

Independent claim 95 provides the additional element of tracking, and the other dependant claims provide for additional elements. In light of the prior art cited by the Examiner and the lack of suggestion of the other claimed elements, Applicant is not focusing on such elements for the purposes of this response. However, Applicant maintains that each claim recites patentably distinct subject matter and reserves the right to address additional differences between the claims in the event the Examiner raises new arguments and/or prior art.

III. THE CLAIMS ARE PATENTABLY DISTINCT FROM THE PRIOR ART

A. The State Of The Art In 1996

In order to fully appreciate the nonobviousness of the invention at the time the first patent application on this technology was filed in 1996, it is important to remember how young the World Wide Web was. At that time, to the extent the public was even aware of the Web, it was primarily viewed as a research tool. Web sites that are considered pioneering today, such as Google, did not exist. Consumers distrusted the idea of buying products over this open and public network. In this environment of consumer distrust, Bill Tobin needed to find a way to sell products over the Web.

Before conceiving his invention, Bill Tobin was already a recognized e-commerce pioneer. In 1992, he was elected Entrepreneur of the Year by *Inc.* magazine in recognition of his e-commerce work on the Prodigy Network. (Tobin Decl. ¶ 4.)¹ In 1994, he founded PC Flowers & Gifts, which sold a wide variety of flowers, balloons, gifts baskets, and foods over the Prodigy Network. (*Id.* ¶ 5.)

At the time he launched his PC Flowers & Gifts Web site, the traditional way for companies to conduct e-commerce was through paid banner advertising on established Web sites. (*Id.* ¶ 6.)

Companies would pay sizable sums to advertise on Internet portals such as Yahoo and AOL. The value of these ads was questionable, and the ads placed nearly all of the financial risk of their effectiveness on the company. (*Id.* ¶ 7.)

¹ Mr. Tobin's declaration was filed December 10, 2002, in the application that was on appeal (09/271,675). For the convenience of the Examiner, a copy of Mr. Tobin's declaration is attached as Exhibit B hereto. The evidence attached to the declaration has not been attached due to its bulk.

To overcome this problem of the conventional e-commerce paradigm, Bill Tobin conceived of various inventions and applied them to his Web site. For example, his Web site generated customized co-branded web pages in response to a user's requests so that the user saw both the brand of the co-branding partner's Web site and the PC Flowers & Gift Web site. (*Id.* ¶ 9.)

Mr. Tobin's idea was a remarkable success. The referring partner benefited because this technological innovation enabled the partner to display its brand to the user even when the user was viewing PC Flowers & Gifts' content on a PC Flowers & Gifts' site. The system also caused the user to associate the partner's brand with e-commerce despite the fact that another company was handling the transaction. (*Id.* ¶ 10.)

Companies like PC Flowers & Gifts also benefited from this innovation because it allowed the company to capitalize on the consumer's existing familiarity of, and trust associated with, the partner's brand. (*Id.* ¶ 11.)

Although the idea of dynamically co-branded Web pages would be considered obvious in light of the technology available on the Internet today, the idea was unquestionably revolutionary eight years ago. In fact, the Examiner of the 09/271,675 application had to combine bits and pieces from *three* different prior art references from disparate fields to even make an argument that the invention was obvious. As is shown below, that combination is motivated only by hindsight.

It is against this backdrop that the prior art will now be addressed.

B. Differences From Art Relied Upon By The Examiners

Because the claims currently pending in this application are amended versions of the claims that were on appeal in the 09/271,675 application, this Response primarily focuses on the rejections of the claims that were pending in that application. For ease of reference and to prevent confusion, the Examiner of the '675 application will be respectfully referred to as the "'675 Examiner." Applicant also attaches a copy of the last Office Action sent in the '675 application as Exhibit C.

The Examiner in this application has made assertions that are somewhat related to the assertions of the '675 Examiner albeit based on different art. Accordingly, even though the claims in this application have been cancelled in favor of the claims that were on appeal in the '675 application, the prior art cited in this application is addressed below as well.

1. Graber, U.S. Patent No. 5,812,769A

The '675 Examiner stated that it was "unclear" whether *Graber* teaches displaying the brands of both a referrer and a destination and, accordingly, did not rely on the reference for this purpose. (Exh. C at 4.)

Even so, there is nothing "unclear" about it. *Graber* does not teach the displaying the brand of a referring Web site.

While *Graber* does teach customizing Web pages, the customization that *Graber* provides is invisible to users and unrelated to brands. Specifically, *Graber* teaches that when a user moves from a first Web site to a second Web site, the second Web site can customize its hyperlinks to include an invisible code that represents the first Web site. The code is not displayed to the user but, rather, is embedded into hyperlinks as a UNIX symbolic link. (See, e.g., *Graber*, col. 5, lns. 41-45.)

Even if *Graber* taught displaying the code to the user which it does not it is clearly not a brand. While the UNIX symbolic link may be intended for and readable by computers, there is no suggestion that it provides any useful information to a user like a brand does. The codes disclosed by *Graber*, such as "\CM1," "\CM2," and "\CM3," reveal that their intended purpose is for use as computer codes, not brands. (*Graber*, col. 12, lns. 43-54.)

Moreover, the very language cited by the '675 Examiner in the office action makes it clear that *codes* are appended to the hyperlink, not *brands*:

a destination web page is determined for the user, and a revised destination web page is formed by *inserting a second representative code* of the identity of the first WWW site *into at least one* selected web page *link* associated with the destination web page.

(*Graber*, col. 3, lns. 43-47; see also Exh. C at 4.)

2. ***Nee, S., "Greetings For All Seasons: Part Two," Sales And Marketing Management, Vol. 1416, No. 10, pp. 139-152 (September 1994)***

In light of *Graber's* failure to teach anything about brands, the '675 Examiner combined *Graber* with *Nee* because *Nee* discloses the "notoriously well known method of customizing a catalogue for a corporate client." (10/7/03 Office Action at 4.) A full copy of the article as it appeared in the magazine is attached as Exhibit D.

Nee teaches that employees can be provided with jackets and other gifts that are customized and imprinted with company logos. (See, e.g., *Nee*, at 142.) Retailers and mail order merchants can also "partially or fully customize a catalogue -- from the cover to the merchandise selection -- for a corporate client." (*Id.* at 144.)

The '675 Examiner's sole evidence of a suggestion that *Nee* and *Graber* could be combined is to ask Applicant to imagine a "corporate client." This imaginary corporate client, it just so happens, wants to create an employee-incentive program that has all of the relevant features of *Graber* and *Nee*:

It would have been obvious to a Person Having Ordinary Skill In The Art, i.e., PHOSITA at the time of the invention to customize the website of *Graber*, for a corporate client, e.g., by creating a custom catalog with a company logo as described by *Nee* . . . in order to provide a customized incentive program for "co-marketers" that were also business associates as described by *Nee* for

instituting employee incentive programs and the like as suggested by the customized catalogues of *Nee*.

(Exh. C at 5.) Such an argument is the *quintessential example of hindsight*. No claim would ever be allowed if it could be rejected based on imaginary people asking PHOSITA's for systems that contain all of the claimed elements.

It is for precisely this reason that the Federal Circuit requires more than just allegations that someone *could* have been motivated to combine prior art to make the claimed invention. "In order to prevent a hindsight-based obviousness analysis, we have clearly established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references." *Ruiz v. A.B. Chance, Co.*, 234 F.3d 654, 664-65 (Fed. Cir. 2000). "While the reference need not expressly teach that the disclosure contained therein should be combined with one another, the showing of combinability must be 'clear and particular.'" *Id.* at 665 (citations omitted).

In fact, there is *nothing* in either *Graber* or *Nee* which clearly suggests that one should be combined with the other. The two simply have nothing to do with one another.

Graber teaches invisibly modifying hyperlinks of Web pages so as to track users as they move around network. *Graber* makes *no* mention or catalogs, brands, or logos.

Nee relates to customizing catalogs and gifts with logos. *Nee* makes *no* mention of computer networks, let alone network-based tracking systems such as *Graber*.

Moreover, the '675 Examiner's assertion that one would "customize the website of *Graber*, for a corporate client, e.g., by creating a custom catalog with a company logo as described by *Nee*" is simply incorrect. *Graber* offers no suggestion of customizing a Web site to alter the elements displayed to a user. The analogy between changing a printed page for branding purposes, as taught in *Nee*, and customizing the visible elements of a Web site is only apparent in hindsight, after applicant has suggested doing so.

As there is no suggestion to combine *Graber* with *Nee*, the § 103 rejection should be withdrawn on this basis alone.

3. ***Coddington, "WhoWhere? Announces
Version 2.0 of Internet Directory Assistance Service,"
Business Wire; New York; April 30, 1996***

The '675 Examiner acknowledged that the *Graber/Nee* combination fails to teach that that co-branding takes place on a destination website such that the brand identifies both the referring site and the destination site. (Exh. C at 5.)

Accordingly, the '675 Examiner relied on *Coddington*. *Coddington* is a press release which states that the "WhoWhere" Web site will have hot links to its partner's Web sites, and that the WhoWhere Web site and the partners will have co-branded Web pages.

In spite of the '675 Examiner's reliance on *Coddington*, this reference does not provide the elements that are missing from the combination of *Graber* and *Nee*, even if all three references could be combined.

a. Coddington Does Not Teach The "Storing" Step

Regardless of whether *Coddington* teaches co-branding on a destination Web site, the fact remains that neither *Coddington*, *Graber*, nor *Nee* teaches the "storing" step of claim 104:

storing a plurality of brands such that a least one brand is associated with each of the plurality of referring sites and the stored brands are accessible by the destination site,

Although the '675 Examiner contended that *Coddington* teaches this step, it does not. The Examiner stated:

Applicant then argues that *Coddington* does not disclose "storing a plurality of brands." This argument is not persuasive. Although *Coddington* may not explicitly disclose the storage, it is inherently shown, as it was by definition in the computer art that any content presented on displays (in this case in a web page) must be stored in some form of memory.

(10/7/03 Office Action at 8.) Applicant admits that in order for a website to show a brand, it is inherent that the brand must have been stored in a place accessible to the Web site.

However, claim 104 requires that the destination site have access to a *plurality* of referring site brands. That is because the destination site (*e.g.*, PC Flowers & Gifts) of the claimed invention is able to display the brands of a plurality of referrers (*e.g.*, Pathfinder, HomeArts).

Yet the destination sites of *Coddington* only display a *single* referring site's brand: WhoWhere. While the press release discloses the possibility of more than one *destination* (such as Switchboard, BigBook, and Quote.com), it does not recognize the possibility of more than one *referrer*. Accordingly, because *Coddington* does not contemplate more than one referrer, it cannot inherently or even impliedly teach the "storing" step of claim 104.

Graber and *Nee* fail to teach the storing element as well. *Graber* does not teach storing a plurality of brands, let alone a plurality of brands of referring sites such that the stored brands are accessible to the destination site. In light of *Nee's* teaching of customized gifts and paper catalogs, the Examiner does not argue not could it be reasonably argued that *Nee* teaches storing a plurality of brands of referring sites such that the stored brands are accessible to the destination site.

Because none of the cited references even arguably teach the storing step, the § 103 rejection must be withdrawn with respect to all claims.

b. The Combination Of Graber, Nee And Coddington Does Not Teach Generating The Page After The Request For The Page

As explained at length above, one of the failures of *Graber* is that it fails to teach the generating page so that the visual appearance of the page is able to change with the identity of the referrer. *Nee* contemplates neither pages nor referrers, and fails on this account as well.

Coddington does not teach this aspect of the invention either. As explained above, the branding of the destination sites never changes because the referrer never changes; the referrer is always WhoWhere. Accordingly, the destination sites can generate their pages in advance of the user's request because the co-branding information never changes.

The present claims, however, expressly wait for the request before generating the page. Both independent claims require: "*after* receiving the request, the destination site generating a page comprising"

Therefore, the combination of all three references does not teach the claimed aspect of waiting for a referral before generating a page so that it includes (1) the brand of the referring site, (2) the brand of the destination, and (3) the destination site's product information.

c. It is Not Obvious To Combine Coddington With The Other Two References

If *Coddington* did disclose the elements that are missing from *Graber* and *Nee*, the rejection under § 103 would still be improper because there is no suggestion to combine the references.

The only motivation cited by the '675 Examiner for the *Graber/Nee/Coddington* combination is the PHOSITA's desire to "generate additional revenue." (10/7/03 Office Action at 5.) The Applicant agrees that use of the invention will result in more revenue. However, a hindsight recognition of the invention's value does not automatically translate into a suggestion to combine the three references together.

In fact, the nature of the references teaches away from their combination. *Coddington* implies a variety of static pages that are already complete with respect to co-branding and product information to be displayed. There is no teaching of customization. (This is in direct contrast to the present invention whose Web pages are not completely assembled with the three items of information until after the Web page is requested.)

In that regard, there would have no suggestion to one of ordinary skill in the art at the time of the invention to combine *Coddington*, *Nee*, and *Graber* together. *Graber* relates to *customized* network pages, *Coddington* relates to *static* network pages, and *Nee* does not relate to networks pages at all. In other words, two references are opposite to one another and the other is completely silent.

There would have been no suggestion to one of ordinary skill in the art at the time of the invention to combine the three cited references and, therefore, the § 103 rejection should be withdrawn.

4. **Person, "Web Publishing With Word For Windows" (1995)**

In light of the fact that the cancelled claims have been replaced with the claims that were on appeal in the '675 application, this application's rejection in view of *Person* is moot.

Regardless, Applicant notes that *Person* is even less relevant than *Coddington*. Both *Person* and *Coddington* teach static Web pages. Both teach links to a plurality of destination pages (such as *Person's* PC Magazine and PC Week), but neither recognizes the possibility of more than one referrer. In fact, *Person* does not even recognize the possibility of any co-branding at the destination.

5. **Dyreson et al., "The Boomerang White Paper:
A Page As You Like It" (November 1995)**

The rejection of the cancelled claims in view of *Dyreson* is similarly moot. Even so, Applicant notes that *Dyreson* suffers the same lack of teaching as the customized Web pages of *Graber*. *Dyreson* does not teach generating a page so that it shows the brand of the referring Web site. Indeed, the Applicant understands the Examiner to agree with this lack of teaching. (See Office Action at 6 ("Dyreson does not explicitly disclose 'combining information contained in said second tagged document with at least said first brand, such that said page contains both said first brand and said second brand.'").)

C. **The Invention's Commercial Success And Other Real-World
Evidence Proves The NonObviousness Of The Invention**

As is apparent, one of the primary issues on this appeal is whether it would have been obvious to one of ordinary skill in the art to combine the teachings of the various references together (assuming that all of the claim elements could be found in the references, which Applicant asserts they cannot).

The Applicant has already submitted a great deal of secondary indicia of nonobviousness to rebut the '675 Examiner's arguments. For reasons that the Applicant does not understand, that evidence was never considered.

1. **The Examiner Has Never Considered Applicant's Secondary
Evidence Of NonObviousness Despite Applicant's Repeated Requests**

"The commercial response to an invention is significant to the determination of obviousness, and is entitled to fair weight." *Vulcan Eng'g Co. v. Fata Aluminum*, 278 F.3d 1366, 1373 (Fed. Cir. 2002) (quoting *Semaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1391 (Fed. Cir. 1988)).

Accordingly, it is well established that the Patent Office must consider evidence of secondary evidence when it is presented by the applicant. "If . . . a patent applicant properly presents evidence relating to these secondary considerations, the board must always consider such evidence in connection with the determination of obviousness." *In re Sernarker*, 702 F.2d 989, 996 (Fed. Cir. 1983).

Despite this requirement and the Applicant's repeated requests, the '675 Examiner never considered Applicant's evidence of nonobviousness. On December 10, 2002, in response to the Examiner's rejection of the invention in view of *Graber* and *Nee*, the Applicant submitted a five-page declaration and dozens of pages of exhibits showing the invention's great commercial success and the accolades that Mr. Tobin received. Mr. Tobin also explained how the invention addressed the long-felt need of remedying the inequities of the then-current Internet advertising paradigm. (Tobin Decl. (attached as Exh. B hereto).)

When the Applicant successfully convinced the '675 Examiner that *Graber* and *Nee* did not render the invention obvious, the Examiner dismissed Mr. Tobin's declaration as "moot" in light of the Examiner's new reliance on *Coddington*. (See '675 3/7/03 Office Action at 7.)

In response, the Applicant explained that *Coddington* made Mr. Tobin's declaration and evidence more pertinent than ever:

Moreover, the Examiner deemed the declaration filed December 13, 2002 as "moot in view of the new ground of rejection." If anything, the declaration is *more* pertinent in light of the new ground of rejection. The declaration shows the commercial success and accolades enjoyed by the invention, further proving its non-obviousness. As such, if it were not obvious to combine *two* references together (*Graber* plus *Nee*), then it is certainly far less obvious to combine *three* references together (*Graber* plus *Nee* plus *Coddington*).

(See '675 Application 7/3/03 Amendment at 7.) Even so, the '675 Examiner made no mention of the Applicant's evidence in the last Office Action of the '675 application (Exh. C.)

Applicant's evidence is so extensive and well documented that it cannot be ignored. Indeed, it compels a determination of nonobviousness.

2. The Invention Has Enjoyed Commercial Success

The commercial success of Mr. Tobin's co-branding invention is clear beyond cavil. By 1999, Mr. Tobin's PC Flowers & Gift company (PCF&G) provided dynamically generated and co-branded floral and gift services in connection with over 1000 co-branded sites, including NBC, CBS, AT&T, Citibank, BellSouth, Merrill Lynch, Yahoo, and MindSpring (now owned by EarthLink). (Exh. B, ¶ 16.) Among the other exhibits to the declaration, Mr. Tobin submitted a list of the 2000 companies that were co-branding marketing partners with PC Flowers & Gifts.

The nexus between the invention and the company's commercial success was so important that the company declared it in its Securities and Exchange Commission filings. (*Id.* ¶ 17.) In 1999, the company declared to the SEC that "[w]e depend on co-branding relationships for more than half of our revenue. Our business would be materially and adversely affected if we cannot maintain our co-branding relationships." (*Id.*)

The commercial success and rapid marketplace embracement of the invention is also evidenced not only by the sheer number of partners, but also PCF&G's revenues and market share. PCF&G became the third largest purveyor of flowers on the Internet, behind only 1-800-FLOWERS and FTD, both of whom utilized the traditional methodology of advertising and had enormous advertising and operation budgets compared to PCF&G. By using Mr. Tobin's invention, PCF&G established significant marketing and advertising presence by spending a comparatively small fraction of its revenues on advertising. (*Id.*) Indeed, the SEC filing noted that "many retailers rely heavily on costly agreements with Internet portal providers to promote their brands." One of PCF&G's strategic responses was to use its co-branding technology "to continuously attract and acquire new customers without significant investments in advertising and marketing." (*Id.* ¶ 18) "Through our co-branding service, our co-branded partners can offer their site visitors a customized flower and gift service while maintaining their own brand identity." (*Id.*)

In the first three months on 1999 alone, PCF&G net sales already exceeded \$1 million, and Mr. Tobin recalls that PCF&G was valued at more than \$100 million at the time of the SEC filing. (*Id.* ¶ 19.)

The commercial success of the invention is also evidenced by the fact that many of today's most popular and successful on-line retailers on the Internet continue to the invention. For example, AOL uses the invention to provide "electronic wallet" services, whereby a Web page is generated to show both the brand of the referring Web site (such as Macy's and OfficeMax) and AOL's brand. (*Id.* ¶ 24.)

3. The Invention Enjoyed Industry Recognition

"Appreciation by contemporaries skilled in the field of the invention is a useful indicator of whether the invention would have been obvious to such persons at the time it was made." *Vulcan Eng'g Co.*, 378 F.3d at 1373.

PCF&G's success due to Mr. Tobin's invention did not go unnoticed.

Numerous industry publications and associations named the company as one of the most successful interactive service providers in the United States. For example, the company received the Editor's Choice Award, from *Looksmart*, Outstanding Web site Award from *WebCrawler*, Seal of Excellence Award from *Web Select Team*, The Outstanding WebAward for 1998 from *The Web Marketing Association*, and Best in Gift Category and Best in Flower Category from *Lycos*. (*Id.* ¶ 21.)

4. The Invention Addressed A Long-Felt Need

Mr. Tobin's invention also addressed the inequities of Web-based advertising. In 1996, the then-current advertising model allowed more affluent competitors, such as 1-800-FLOWERS or the like, to pay millions of up-front dollars to be the most prominent or exclusive merchant for goods in their category on the most important Web sites. (*Id.* ¶ 14.) With Mr. Tobin's invention, the only substantial

cost was the development of the co-branded Web site and commissions on actual sales. Thus, his invention permitted small and mid-sized companies to compete with the large and well-funded companies in e-commerce, and reach the public via the Web in an extremely cost-efficient manner.

5. Conclusion


Applicant respectfully submits that a determination of non-obviousness is compelled in light of the failure of the cited references to teach all of the claimed elements, the lack of suggestion or motivation to combine the cited references, as well as the documented evidence of commercial success, industry recognition, and the invention's fulfillment of a long-felt need.

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Allowance of all pending claims is respectfully requested. If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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